

RESPONSE UNDER 37 C.F.R. § 1.116

EXPEDITED PROCEDURE – Art Unit 3652

Attorney Docket No. 108298352US4

Disclosure No. 98-0689.04/US

REMARKS

Claims 25-34 and 64-73 are currently pending in the present application. No claims have been amended or canceled in this response.

In the Final Office Action mailed December 14, 2005, claims 31, 32 and 64 were rejected. More specifically, the status of the claims in light of this Office Action is as follows:

(A) Claims 31, 32 and 64 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,906,472 to Nakamura ("Nakamura");

(B) Claims 25-30 were allowed; and

(C) Claims 34 and 65-73 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form to include the features of the claims from which they depend.

A. Response to the Section 102(e) Rejection

Claims 31, 32 and 64 were rejected under 35 U.S.C. § 102(e) as being anticipated by Nakamura. As set forth below, Nakamura fails to disclose or suggest all the features of these claims.

1. Claim 31 is Directed to a Retainer for Holding a Tray Stack Including, *inter alia*, a Casing and a Floating Plate Moveably Positioned in the Casing

Claim 31 is directed to a retainer for holding a tray stack having a plurality of trays that are configured to carry microelectronic devices. The retainer includes a casing having (a) a guide structure with a first end and a second end, (b) an interior holding area, and (c) an opening at least proximate to the second end. The guide structure is configured to support the tray stack with respect to a load/unload path and allow the tray stack to move through the guide structure along the load/unload path. The retainer further includes a plurality of moveable retaining elements at least proximate to the second end of the guide structure. The retaining elements are moveable between a storage position and a load/unload position. In the storage position, the retaining elements project into the interior holding area of the casing. In the load/unload

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position, the retaining elements either do not project as far into the interior holding area or are completely removed from the interior holding area. The retainer also includes a floating plate moveably positioned in the casing to move along the load/unload path defined by the guide structure. The floating plate pushes the trays against the retaining elements when the retaining elements are in the storage position, and the floating plate pushes the trays out of the casing when the retaining elements are in the load/unload position.

2. Nakamura Discloses a Tray Removing Apparatus Having an Elevator Positioned Below a Storage Container

Nakamura discloses a tray removing apparatus for removing trays from a tray storage container. The tray storage container has an opening. The tray removing apparatus includes (a) first and second engagement hooks 12A and 12B positioned at the opening and external to the storage container, (b) a tray carrier 18 spaced apart from the opening and positioned below the engagement hooks 12A and 12B, and (c) an elevator 14 movable between the engagement hooks 12A and 12B and the tray carrier 18. The first engagement hooks 12A support the stack of trays after the stack is partially removed from the tray storage container. The first and second engagement hooks 12A and 12B operate together to release one tray at a time from the stack. The elevator 14 receives each released tray from the second engagements hooks 12B and carries the tray downward to the tray carrier 18. As such, the elevator 14 is external to the tray storage container throughout the unloading process. The tray carrier 18 subsequently transports each tray to a testing apparatus.

3. Nakamura Fails to Disclose or Suggest a Retainer for Holding a Tray Stack Including, *inter alia*, a Casing and a Floating Plate Moveably Positioned in the Casing

Nakamura fails to disclose or suggest a retainer for holding a tray stack including, *inter alia*, a casing and "a floating plate moveably positioned in the casing," as recited in claim 31. In the Final Office Action mailed December 14, 2005, the Examiner asserts, "Nakamura discloses all of the claim limitations in a similar device in FIG. 5, the device comprising a(n): Casing KAS . . . [and] floating plate 14." (Final Office Action, p. 2.) Even if Nakamura's tray storage container KAS and elevator 14 correspond to the casing and floating plate, respectively, of claim 31 as suggested by the Examiner, Nakamura's elevator 14 is never positioned in his tray storage

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container KAS. Rather, during operation of Nakamura's apparatus, Nakamura's elevator 14 moves between (a) a first position in which the elevator 14 receive trays from the second engagement hooks 12B and is positioned external to the tray storage container KAS, and (b) a second position in which the elevator 14 places trays on the tray carrier 18 and is positioned external to the tray storage container KAS. Accordingly, Nakamura does not disclose "a floating plate moveably positioned in the casing," as required by claim 31.

Moreover, one skilled in the art would not be motivated to modify Nakamura's apparatus and position the elevator 14 within the storage container KAS because in such a position the elevator 14 could not carry individual trays to the tray carrier. Specifically, Nakamura's first and second engagement hooks 12A and 12B operate together to release one tray at a time from the tray stack so that the elevator 14 can carry individual trays to the tray carrier 18. The individual trays are then transported to a testing apparatus. If Nakamura's elevator 14 were positioned in the storage container KAS, the first and second engagement hooks 12A and 12B could not operate to release individual trays and the elevator 14 would not be able to carry individual trays from the tray stack to the tray carrier 18. Rather, the elevator 14 would carry multiple stacked trays to the tray carrier 18, which in turn would deliver the stacked trays to the testing apparatus. Accordingly, one skilled in the art would not be motivated to modify Nakamura's apparatus and position the elevator 14 within the storage container KAS. Therefore, the Section 102(e) rejection of claim 31 should be withdrawn because (a) Nakamura fails to disclose or suggest all the elements of claim 31, and (b) one of ordinary skill in the art would not be motivated to modify Nakamura's device to include all the elements of claim 31.

In the Final Office Action, the Examiner asserts that the applicants' arguments are directed to the function performed by Nakamura's apparatus. Specifically, the Examiner states:

With respect to claim 31, Applicant's arguments are drawn toward what the device does. For example, the applicant argues that Nakamura's apparatus "is not moveably positioned in the storage container and does not push the trays out of the container. Rather, Nakamura's elevator is positioned outside the storage container to move trays from the engagement hooks to the tray carrier." Applicant is respectfully reminded that claim language consisting of functional language and/or intended use phrasing is given little,

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if any, patentable weight as the apparatus must merely be capable of functioning, or being used, as claimed.

(Final Office Action, pp. 2-3; emphasis added).

Applicants respectfully disagree. The applicants' arguments in this response and in the previous response are directed to structural differences between claim 31 and Nakamura's apparatus. Specifically, as shown above in the underlined text, the applicants argue that Nakamura fails to disclose or suggest, *inter alia*, "a floating plate moveably positioned in the casing," as required by claim 31. This claim feature is structural, and is not a functional recitation directed to an intended use. Therefore, this claim feature should be accorded proper patentable weight.

Claim 32 depends from claim 31. Accordingly, the Section 102(e) rejection of claim 32 should be withdrawn for at least the reasons discussed above with reference to claim 31 and for the additional features of this claim.

Independent claim 64 has, *inter alia*, features generally analogous to the features of claim 31. Accordingly, the Section 102(e) rejection of claim 64 should be withdrawn for at least the reasons discussed above with reference to claim 31 and for the additional features of this claim.

B. Objection to Claims 34 and 65-73

Claims 34 and 65-73 were objected to as being dependent upon a rejected base, but were indicated to be allowable if rewritten in independent form to include the features of the claims from which they depend. These claims have not been rewritten in independent form because the rejection of their respective independent claims should now be withdrawn.

C. Conclusion

In view of the foregoing, the pending claims comply with 35 U.S.C. § 112 and are patentable over the applied art. The applicants accordingly request reconsideration of the application and a Notice of Allowance.

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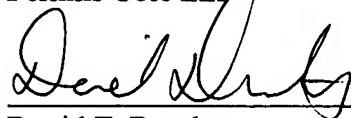
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If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call David Dutcher at (206) 359-6465.

Respectfully submitted,

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